

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE BOARD OF APPEALS AND PATENT INTERFERENCES

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| In re patent application of: |) Date: October 31, 2007 |
| David K. Lee, et al. |) Attorney Docket No.: F-260 |
| Serial No.: 09/927,963 |) Customer No.:00919 |
| Filed: August 10, 2001 |) Group Art Unit: 3628 |
| Confirmation No.: 6878 |) Examiner: Jabr, Fady S |
| Title: | METHOD AND APPARATUS FOR TRACKING MAIL ITEMS THROUGH A CARRIER DISTRIBUTION SYSTEM |

BRIEF ON APPEAL

Sir:

This Appeal Brief is being filed pursuant to 35 U.S.C. Section 134 from the final rejection of claims 1-2 and 4-10 mailed May 02, 2007. **Pursuant to MPEP 1208.02, no fee is believed due because the fee for filing this Brief on Appeal was previously paid for in this application with the filing of a prior Brief on Appeal.** Authorization is hereby given to charge deposit account number 16-1885 for all fees required to be paid in connection with this Appeal.

REAL PARTY IN INTEREST

The real party in interest is Pitney Bowes Inc. which acquired all rights to the above-identified application by way of an assignment which was recorded in the Assignment Branch of the United States Patent and Trademark Office on August 10, 2001 at Reel 012084 and Frame 0382.

RELATED APPEALS AND INTERFERENCES

There are no related Appeals or Interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in the instant appeal.

STATUS OF CLAIMS

The instant application was originally filed with claims 1-21. In an amendment filed February 27, 2007 claims 1 and 2 were amended and claims 3 and 11-21 were cancelled. Accordingly, claims 1-2 and 4-10 are currently pending and are being appealed.

STATUS OF AMENDMENTS

No Amendments are currently pending. Pending claims 1-2 and 4-10 are set forth in Appendix A.

SUMMARY OF CLAIMED SUBJECT MATTER

The instant summary of the invention is being given by way of example and is not intended to limit the scope of the claims in any manner. By way of background, the instant inventors observed that in many private and postal carrier distribution systems, a number of issues arise with respect to the ability of the sender of an item to track the item within the carrier's system. For example, since carriers typically track the item using a unique carrier assigned number that is applied by the carrier to the item, the sender must have some type of upfront communication with the carrier to obtain the unique carrier assigned number to permit inquiries by the carrier as to the tracking status of the item. Thus, the sender must either 1) physically bring the item to the carrier in order to receive the carrier's unique assigned tracking number, which may take a great deal of time, or 2) obtain such unique numbers from the carrier via some type of electronic communication such as the internet. However, while the online system helps minimize the time problem associated with physically bringing the mailpiece to the carrier, it creates another problem for the carrier in that the carrier cannot be sure

that the unique carrier generated number was properly affixed to a specific item by the sender.

The instant inventors solved the above problem by using two unique identifiers: one **(13) (paragraph 0014, Fig. 1)** created by the sender and the other **(41) (paragraph 0019, Fig. 3)** created by the carrier. A user generates the unique sender identifier **(13)** during the creation of the mailpiece and submits it into the carrier distribution system, together with the item (i.e. mailpiece) without knowing anything else about the internal workings of the carrier's tracking system **(21) (Paragraph 0019, Fig. 4 step 42, Fig. 2) (inducting step of claim 1)**. The carrier obtains knowledge of the sender's unique identifier **(13)** by reading it off of the mailpiece **(Fig 4 step 43 and paragraph 0019) (obtaining step of claim 1)** and then associates the sender's unique identifier with the unique identifier **(41)** created by the carrier that the carrier uses to track the item **(Paragraph 0019) (assigning, associating and tracking steps of claim 1)**. Thus, when a sender wishes to check on the tracking status of their item, they only need to provide the sender's unique identifier to the carrier and they don't need to know anything about the carrier's unique identifier **(Paragraph 0024) (allowing step of claim 1)**. The carrier, via the created association between the sender's unique identifier and the carrier's unique identifier, can identify the mailpiece and report the tracking status back to the sender **(Paragraph 0024) (providing step of claim 1)**. This system allows for a sender to, for example, drop a mailpiece into a carrier's drop box with a sender's unique identifier located thereon and still be able to track the mailpiece without receiving any unique identifier tracking information from the carrier **(Paragraph 0024)**.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

At issue in this Appeal is the propriety of the following rejections:

1. Claim 6 stands rejected under 35 U.S.C. Section 112, Second Paragraph as being indefinite.

2. Claims 1-2, 4-7 and 9-10 stand rejected under 35 U.S.C. 103(a) as being obvious over **Wheeler (Pub No. US2002/0032623 A1)**.

3. Claim 8 stands rejected under 35 U.S.C. Section 103(a) as being obvious over **Wheeler (Pub No. US2002/0032623 A1) in view of Park (Pub. No. US2001/0010334 A1)**.

ARGUMENTS

Issue 1

The Examiner has taken the position that the recitation “the carrier obtaining the address from the unique sender generated identifier and supplying to the address information about the location of the mail item” is unclear. Applicants submit that this language is completely consistent with the description set forth in the specification.

By way of example, and not limitation, the Examiner is directed to the electronic address and identifier mark (EAIM 13) which is a unique identifier of a sender that includes an electronic address(for example, email address) of a sender combined with a unique number (Paragraph 0014 of the specification). As the mail item is processed through the carrier distribution system of Figure 2 the EAIM 13 is read by the Advanced Facer/Canceler 23 (AFC) to obtain the email address of the sender (Paragraph 0023). Once the carrier distribution system has the email address it can send confirmation information or track and trace mail item location information to that email address (see paragraphs 0006, 0023, 0024, and 0027 sub-paragraph 5). It is submitted that claim 6 clearly recites that location information about the mail item being processed through the carrier distribution system is sent to an address obtained from the unique sender generated identifier (for example EAIM 13). Accordingly, it is submitted that claim 6 particularly points out and distinctly claims subject matter which the Applicants regard as their invention and which is fully supported by the specification.

Issue 2

Claim 1

In order to avoid redundancy the Summary of the invention is incorporated into this argument by reference. As highlighted in the Summary, an important aspect of the invention is that the sender is only required to assign its own unique identifier to the mail item. Everything else is done within the carrier distribution system by the carrier. The result of this claimed invention is that both the problems of 1) requiring a sender to have knowledge of the carrier's unique identifier for the mailpiece and 2) the need to prevent improperly assigning a carrier's unique identifier to the wrong mailpiece are overcome.

Wheeler is directed to a method and apparatus that tracks a mail item **within a single company's or organization's interoffice mail system.** In this system a user 100 generates a mail item 250 and uses the interoffice system 10 to track the mailpiece using a unique tag 255 (comprised of ID 262 and bar code 264). The user (sender) creates the unique tag 255 and applies it to the mail item 250.

Wheeler at paragraphs 0012 and 0080 describes **how the user/user organization can create a unique carrier generated tag and apply the unique carrier generated tag to the mail item 250.** The mail item 250 would then be inducted into the carrier distribution system and the carrier would use the unique carrier generated tag to track the mail item 250 during its processing through the carrier distribution system. There is no discussion of the sender organization providing the carrier with the unique user generated tag or the carrier reading or using such user generated unique ID tag to permit an inquiry from the sender for tracking information to be answered by the carrier simply based on providing to the carrier the user generated tag. The carrier system of Wheeler is simply the conventional system whereby the user must provide the carrier's tracking number to the carrier in order to obtain tracking information for the mail item 250.

Claim 1 specifically recites that 1) the unique sender generated identifier is obtained from the mail item **in the carrier distribution system**, 2) the unique carrier generated identifier **is assigned to a mailpiece in the carrier distribution system**, 3) the unique carrier generated identifier and the unique sender generated identifier are associated with each other **in the carrier distribution system**, and 4) the carrier distribution system **receives the unique sender generated identifier from the sender as part of a request for location information about the mail item without the sender having knowledge of the unique carrier generated identifier and the carrier distribution system provides the location information in response to the request.**

It is submitted that none of the 4 elements set forth in the immediately preceding paragraph are taught or suggested by Wheeler. In Wheeler the sender and carrier ID tags are both generated **by the sender**, assigned to the mailpiece **by the sender**, and associated with each other **by the sender**. Further, there is no discussion of the carrier reading the sender generated ID tag or using that ID tag for any purpose. Finally, there is no discussion at all in Wheeler that the user generated ID tag can be used to obtain location information about the mailpiece 250 from the carrier or that the carrier can provide location information about the mailpiece 250 to the sender **without the sender knowing the unique carrier generated ID tag.**

Fundamentally, Wheeler requires the sender to know the unique carrier generated ID tag defeating the very purpose of the invention which is to eliminate such requirement. Additionally, since the sender applies the unique carrier identifier to the mailpiece Wheeler teaches the very problem the inventors wanted to overcome which is loss of control of the application of the unique carrier generated identifier to the mailpiece by the carrier.

Finally, the Examiner's position that since both a sender ID tag and a carrier ID tag are shown by Wheeler it would have been obvious to use such ID's as claimed is simply not supported by the Wheeler specification. As discussed above Wheeler actually teaches away from the claimed invention. Essentially,

teaching away from the art is a per se demonstration of lack of prima facie obviousness. *In re Dow Chemical Co.*, 837 F.2d 469, USPQ 685 687 (Fed. Cir. 1986). Applicants submit that the Examiner's only support for saying that Wheeler renders the claimed method steps obvious comes from the Applicants' own specification. Such hindsight use of the Applicants' specification is not proper to establish a prima facie case of obviousness. It is also very clear that the examiner has not pointed to something in the prior art that suggests in some way the proposed modification of Wheeler to arrive at the claimed invention. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching, suggestion, or incentive supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)

In view of the above arguments it is submitted that independent claim 1 is not rendered obvious in view of Wheeler. Further, it is submitted that dependent claims 2, and 4, and 7-10 are also patentable over Wheeler based on their dependency from claim 1 and the inventive combination they create with claim 1.

Claim 5

With respect to claim 5 it is recited that the unique sender generated identifier is located proximate to the recipient address and **is used to locate the recipient address**. As discussed at paragraph 0023, starting at line 16, the EAIM 13, which can be in the form of a barcode, can effectively be used to find and parse the address block since a barcode is highly distinguishable from regular text. While Wheeler shows the identifier as being located proximate the recipient address there is no teaching or suggestion of a method step of using such identifier as a way of locating such recipient address.

Claims 6

Claim 6 recites that the unique sender generated identifier includes an address therein (such as the email address embedded in the EAME 13 of the

Applicant's specification). Claim 6 also recites that the carrier obtains this address information from the sender identifier and sends location information about the mailpiece to the obtained address. As set forth in claim 7 the address can be one of an email, a page number, or a facsimile machine number. None of paragraphs 0006, 0038, 0008, or 0009 teach or suggest **including in the sender generated identifier** any of the aforementioned addresses or any other address for that matter. Wheeler discusses sending information about a mail item to an email address but doesn't teach or suggest including the address as part of the unique sender generated identifier.

Issue 2

Claim 8

Claim 8 stands rejected as being unpatentable over Wheeler in view of Park. Claim 8 depends from claim 1 and is considered patentable for the reasons discussed above regarding claim 1 and because Park does not correct the deficiencies of Wheeler.

SUMMARY

It is submitted for each of the reasons enumerated above that claims 1-2, and 4-10 are not rendered obvious in view of the applied references. Accordingly,

the Appellants respectfully request that the Board reverse the Examiner with respect to the rejections set forth in the final Office Action.

Respectfully submitted,

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APPENDIX A – Claims

1. A method for tracking through a carrier distribution system a mail item created by a sender, the method comprising the steps of:

inducting the mail item into the carrier distribution system, the mail item having thereon a unique sender generated identifier;

obtaining the unique sender generated identifier from the mail item during processing of the mail item in the carrier distribution system;

assigning a unique carrier generated identifier to the mail item during processing of the mail item in the carrier distribution system;

associating the unique sender generated identifier with the unique carrier generated identifier during processing of the mail item in the carrier distribution system;

the carrier tracking the location of the mail item through the carrier distribution system using the unique carrier generated identifier;

allowing the sender to obtain location information about the mail item using the unique sender generated identifier without the sender having knowledge of the unique carrier generated identifier by receiving at the carrier distribution system a request from the sender for location information about the mail item, the request including the unique sender generated identifier but not the unique carrier generated identifier; and

providing the location information to the sender in response to the request.

2. The method as recited in claim 1, further comprising the carrier applying the unique carrier generated identifier to the mail item.

4. The method as recited in claim 2, wherein the unique sender generated identifier is in a bar code form.

5. The method as recited in claim 4, wherein the mail item has a recipient address printed thereon and the unique sender generated identifier is located on the mail item proximate the recipient address and further comprising using the unique sender generated identifier for locating the recipient address.
6. The method as recited in claim 1, wherein the unique sender generated identifier includes an address and further comprising the carrier obtaining the address from the unique sender generated identifier and supplying to the address information about the location of the mail item.
7. The method as recited in claim 6, wherein the address is one of an e-mail address, a pager number, and a facsimile machine number.
8. The method as recited in claim 1, wherein the unique sender generated identifier includes an electronic address and additional data that uniquely identifies the mail item.
9. The method as recited in claim 1, further comprising uniquely associating the unique sender generated and unique carrier generated identifiers by storing them in a file.
10. The method as recited in claim 9, further comprising reading the unique carrier generated identifier at a plurality of locations throughout the carrier distribution system, storing in the file a date stamp, a time stamp, and a location identifier each time the reading of the unique carrier generated identifier occurs, and associating in the file the date stamp, time stamp, and location identifier with the unique carrier generated identifier and the unique sender generated identifier.

APPENDIX B –Evidence

None

APPENDIX C –Related Proceedings

None